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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,021	11/13/2003	Atsushi Kato	075834.00447	1983
33448 7590 09/12/2008 ROBERT J. DEPKE LEWIS T. STEADMAN ROCKEY, DEPKE & LYONS, LLC SUITE 5450 SEARS TOWER CHICAGO, IL 60606-6306				
EXAMINER BERNATZ, KEVIN M				
ART UNIT 1794		PAPER NUMBER		
MAIL DATE 09/12/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/714,021

Applicant(s)

KATO ET AL.

Examiner

Kevin M. Bernatz

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. Addition of claim 15, filed on June 19, 2008, has been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1 – 4 and 8 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al. (U.S. Patent No. 6,045,901) in view of Oguchi et al. (U.S. Patent No. 5,470,645) for the reasons of record as set forth in Paragraph No. 4 of the Office Action mailed on December 18, 2007, which refers back to Paragraph No. 3 of the Office Action mailed on May 29, 2007.

Regarding new claim 15, Hashimoto et al. disclose forming multi-layered magnetic recording media wherein both the upper and lower magnetic layers possess the inventive polyurethane (*col. 3, lines 28 – 37*). It would therefore have been obvious to one of ordinary skill in the art at the time of Applicants' invention to likewise use similar additives in both the upper and lower magnetic layers (*i.e. the polar group for insuring good smoothness of the layers – col. 3, lines 38 – 56*). Oguchi et al. further support this (*col. 4, line 54 bridging col. 5, line 10*).

4. Claims 1 – 4 and 8 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murayama et al. (U.S. Patent No. 6,010,773) in view of Oguchi et al. ('645) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on December 18, 2007, which refers back to Paragraph No. 4 of the Office Action mailed on May 29, 2007.

Regarding new claim 15, Murayama et al. disclose forming multi-layered magnetic recording media wherein both the upper and lower magnetic layers possess the claimed polar group (*col. 6, lines 26 – 36 and col. 8, lines 1 – 11*). Oguchi et al. further support this (*col. 4, line 54 bridging col. 5, line 10*).

Response to Arguments

5. The rejection of claims 1 – 4 and 8 - 15 under 35 U.S.C § 103(a) – Hashimoto et al. in view of Oguchi et al.

The rejection of claims 1 – 4 and 8 - 15 under 35 U.S.C § 103(a) – Murayama et al. in view of Oguchi et al.

Applicant(s) arguments have been considered but the Examiner notes that Applicants have provided no detailed arguments as to why they feel “the Examiner does not have appropriate support for this obviousness rejection”. The Examiner notes that proper support can be found in the basis of the rejection, as set forth above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicants' amendment resulted in embodiments not previously considered (i.e. addition of new claim 15) which necessitated the new grounds of rejection, and hence the finality of this action.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The Examiner can normally be reached on M-F, 8:30 AM - 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin M. Bernatz, PhD/
Primary Examiner, Art Unit 1794

September 10, 2008